



S/N 07/330,446

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Yoshimura et al.	Examiner:	D. Jacobson
Serial No.:	07/330,446	Group Art Unit:	1653
Filed:	March 30, 1989	Docket No.:	11613.12US11
Title:	HUMAN DERIVED MONOCYTE ATTRACTING PURIFIED PROTEIN PRODUCT USEFUL IN A METHOD OF TREATING INFECTION AND NEOPLASM IN A HUMAN BODY, AND THE CLONING OF FULL LENGTH cDNA THEREOF		

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited in the United States Postal Service, as first class mail, with sufficient postage, in an envelope addressed to: Commissioner for Patents, Technology Center 1600, P.O. Box 1450, Alexandria, VA 22313-1450 on May 7, 2003.

By: 

Name: Tracy L. Hollom

**PETITION TO WITHDRAW HOLDING OF ABANDONMENT
BASED ON NON-RECEIPT OF AN OFFICE ACTION**

RECEIVED

Commissioner for Patents
Technology Center 1600
P.O. Box 1450
Alexandria, VA 22313-1450

MAY 14 2003

TECH CENTER 1600/2900

Dear Sir:

Applicants respectfully petitions the Commissioner to Withdraw the Holding of Abandonment in the above-referenced application ("the application") based on non-receipt of an office action. No fee is believed to be due for consideration of this petition. In the event that a fee is due, the Commissioner is authorized to charge such fee to Deposit Account No. 13-2725.

Facts relating to abandonment

The facts relating to the abandonment of the application are as follows.

- (A) On June 19, 1997, Applicants submitted a revocation and power of attorney ("the revocation"), in which the original power of attorney to Birch, Stewart, Kolasch & Birch ("Birch, Stewart") was revoked in favor of Merchant & Gould P.C. ("Merchant & Gould"). A copy is attached as Exhibit A-1. The revocation was

received by the USPTO on June 23, 1997, as evidenced by the return postcard, a copy of which is attached as Exhibit A-2. The revocation contained an address for Merchant & Gould to which all future communications were to be addressed.

- (B) On April 21, 1999, the Examiner mailed an office action addressed to Birch, Stewart. A copy of the cover sheet for this office action is attached as Exhibit B.
- (C) On October 21, 1999, Applicants responded to the office action. A copy of the response is attached as Exhibit C. In the response, Applicants again advised the USPTO that the correspondence address had changed in view of the revocation submitted on June 19, 1997 (see page 2 of the response).
- (D) On February 15, 2000, the Examiner again mailed an office action addressed to Birch, Stewart. A copy of the cover sheet for this office action is attached as Exhibit D.
- (E) On August 15, 2000, Applicants submitted a response to the office action. A copy of the response, including transmittals showing all papers submitted, is submitted as Exhibit E-1. The response again advised the USPTO of the revocation and that the correspondence address had changed (see page 2 of the response). The papers submitted with the response also included a change of address paper, notifying the USPTO of the new correspondence address, and a copy of the return postcard from the revocation. Copies are attached as Exhibit E-2.
- (F) According to a PAIR print-out, an office action was mailed on September 28, 2000. A copy of the PAIR print-out is attached as Exhibit F.
- (G) On May 8, 2001, a Notice of Abandonment was mailed to Birch, Stewart. A copy of the Notice of Abandonment is attached as Exhibit G.

- (H) On March 22, 2002, Applicants filed a Request for Remailing of Office Action ("the March 22, 2002 request"). A copy is attached as Exhibit H. The March 22, 2002 request noted the previously filed notices with the USPTO concerning the revocation and change of address that occurred, and requested remailing of the office action and resetting of the response period. Further, the March 22, 2002 request also contained a statement "In the event this request is denied, it is requested that the application be revived as unintentionally abandoned. Any fees can be charged to Deposit Account 13-2725.". (See page 2 of the March 22, 2002 request).
- (I) On May 14, 2002, a new Notice of Abandonment was mailed to Merchant & Gould. A copy is attached as Exhibit I.

The holding of abandonment should be withdrawn

After checking appropriate records, Applicant's appointed counsel cannot find any evidence that the office action mailed September 28, 2000 was received by Merchant & Gould. Applicants surmise that this document was sent to Birch, Stewart, despite the previous notices submitted to the USPTO concerning the new correspondence address. A copy of the docket record showing where the office action would have been docketed had it been received by Merchant & Gould is attached as Exhibit DR. Applicants have assumed that the office action was a final office action, and had a mailing date of September 28, 2000. The docket record has been redacted to protect confidential client information.

Applicants submitted the March 22, 2002 request that the office action be remailed, based on non-receipt of the office action. The March 22, 2002 request also contained an alternative request that the application be revived as unintentionally abandoned. The March 22, 2002 request should have at least been treated as a petition to withdraw the holding of abandonment based on non-receipt of the office action. In the alternative, the March 22, 2002 request should have been treated as a petition under 37 CFR 1.137 to revive an unintentionally abandoned application.

Therefore, at least as early as March 22, 2002, Applicants filed what should have been treated at least as a petition to withdraw the holding of abandonment, or alternatively a petition to revive an unintentionally abandoned application. Despite the March 22, 2002 request, another notice of abandonment was mailed May 14, 2002.

Since the March 22, 2002 request, Applicants have been waiting for action from the USPTO on Applicants request to remail the office action. However, it does not appear that any action has been taken on Applicants request. Therefore, Applicants are filing this petition to once again request withdrawal of the holding of abandonment based on non-receipt of the September 28, 2000 office action.

If necessary, Applicants request waiver under 37 CFR 1.183 of the two-month time period set forth in 37 CFR 1.181(f). Waiver is necessary to avoid the injustice to the Applicants that would result from holding the application abandoned even though Applicants did not receive the office action and despite Applicants repeated notices to the USPTO concerning the new correspondence address.

Petition to revive abandoned application

In the alternative, Applicants respectfully petition the Commissioner under 37 CFR 1.137(b) to revive the application based on unintentional abandonment. Because the office action was not received, Applicants request waiver under 37 CFR 1.183 of the reply requirement set forth in 37 CFR 1.137(b)(1) if the March 22, 2002 request, or this paper, do not satisfy the reply requirement.

With respect to 37 CFR 1.137(b)(3), Applicants submit that the entire delay between the mailing of the May 8, 2001 notice of abandonment and the filing of the March 22, 2002 request was unintentional. Moreover, Applicants submit that the entire delay between the mailing of the May 14, 2002 notice of abandonment and the filing of this paper was unintentional.

The Commissioner is authorized to charge any fee that may be required under 37 CFR 1.137(b)(2) to Deposit Account No. 13-2725.

Applicants request waiver under 37 CFR 1.183 of the terminal disclaimer requirement set forth in 37 CFR 1.137(b). Waiver is necessary to avoid injustice to Applicants in the form of a loss of patent term that would result from the filing of a terminal disclaimer. The abandonment

of the application, the need for a terminal disclaimer, and the resulting loss of patent term, could have been avoided had Applicant's notices of the new correspondence address been acted on by the USPTO.

Conclusion

Because the September 28, 2000 office action was not received by Applicant's appointed counsel, the application should not be abandoned and the office action should be remailed to Applicants with a new time period for response. Alternatively, the application should be revived based on unintentional abandonment.

Any questions concerning this petition should be directed to the attention of the undersigned at the number provided below.

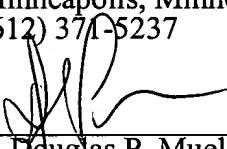
Respectfully submitted,

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Dated

May 7, 2003

By:



Douglas P. Mueller
Reg. No. 30,300
DPM/JAL